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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/419,788	10/18/1999	RAINER FISCHER	0147-0189P	1798

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EXAMINER

NOLAN, PATRICK J

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 01/28/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/419,788**

Applicant(s)  
**Fischer et al.**

Examiner  
**Patrick J. Nolan**

Art Unit  
**1644**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jul 29, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 18-44 is/are pending in the application.
- 4a) Of the above, claim(s) 21-28, 30-35, and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 18-20, and 41-43 is/are rejected.
- 7) ☒ Claim(s) 13, 29, 36, 38-40, and 44 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

1. Claims 1-14 and 18-42 and newly added claims 43-44 are pending.
2. Claims 21-28, 30-35, and 37 (non-elected Groups G-L) stand withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b) as being drawn to a non-elected invention, for reasons set forth in Paper No. 16.

Claims 1-14, 18-20, 29, 36, and 38-42 wherein the fusion protein comprises a binding domain comprising an antibody that specifically recognizes an epitope of a plant pathogen and wherein the membrane localization sequence leads to membrane anchoring are under consideration in the instant application.

3. It is also noted that as far as claim 36 is concerned the Marked up copy and the official copy of the claims in the amendment submitted 7-29-02 do not match. The Examiner examined the case by the recitation of claim 36 in the official copy of the claims.

4. Claim 29 stands objected to as being dependent on non-elected claims 21 and 28.

Applicant has asserted that claim 29 has been cancelled. No direction from Applicant in the proper section of the Amendment has directed the Office to cancel said claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-12, 14, 18-20, 41-42 and newly added claim 43 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/09398, for reasons of record set forth in Paper No. 16.

Applicant's arguments filed 7-29-02 have been fully considered but are not found persuasive. Applicant argues that the '398 patent does not teach membrane targeting sequences and so therefore the reference cannot anticipate the claimed invention.

However, targeting sequences are taught for targeting the fusion protein to chloroplasts, mitochondria, peroxisomes or the nucleus, all organelles are recognized to be encompassed by membranes, thereby meeting the limitation of the claim.

6. Applicant is notified that claims 13, 36, 38-40 and 44 are objected as being dependent upon rejected claims.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed,

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and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Monday through Thursday from 9:30 am to 4:30 pm.

9. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7939. Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.



Patrick J. Nolan, Ph.D.

Primary Examiner, Group 1640

1/26/03